

25 MAY 2004



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In re Application of	:	
ASANO, Kenji, et al.	:	
Application No.: 09/856,716	:	
PCT No.: PCT/JP99/06615	:	
Int. Filing Date: 26 November 1999	:	DECISION ON
Priority Date: 27 November 1998	:	
Attorney Docket No.: 0230-0160P	:	PETITION UNDER
For: LAK ACTIVITY-SCREENING	:	
MATERIALS CONTAINING LENTINUS	:	37 CFR 1.47(a)
EXTRACT OF EDODES MYCELIUM	:	
AND LAK ACTIVITY-SCREENING	:	
METHODS USING THE EXTRACT	:	

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. §1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 05 December 2003.

BACKGROUND

On 26 November 1999, applicants filed international application PCT/JP99/06615, which claimed a priority date of 27 November 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 08 June 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 November 1999, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 May 2001 (27 May 2001 was a Sunday).

On 25 May 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 28 June 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 28 January 2002, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a combined declaration and power of attorney executed by inventors Kenji Asano and Yukiko Matsuda, a petition for a five month extension of time and the fee for a five month extension of time.

On 17 May 2002, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 18 November 2002, applicants submitted "Renewed Petition Under 37 C.F.R. §1.47(a)" accompanied by the fee for a four month extension of time.

On 13 May 2003, applicants submitted a copy of the 18 November 2002 petition by facsimile.

On 05 September 2003, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition for failure to supply proof of pertinent facts.

On 05 December 2003, applicants submitted a second renewed petition accompanied by the fee for a one month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1), (3) and (4) were previously met.

Item (2) has not been satisfied. To establish refusal to sign the applicant papers, applicants must detail the circumstances of the presentation of the application papers and of the refusal in the statement of facts by the person who presented the application papers to the inventor and/or to whom the refusal was made. MPEP 409.03(d). An express statement that the application papers should not be sent may be sufficient, but the time and place of the refusal must be stated in the statement of facts.

The declaration of attorneys Kurita and Ejiri indicates that the non-signing inventor was sent only the "oath"¹ and assignment and that the package did not include a complete copy of the application papers, including the specification with claims and drawings. Applicants claim that inventor Tajima is familiar with the invention, but that is not sufficient to make out a refusal to sign as the MPEP indicates

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers.

MPEP409.03(d). There is no allegation that the inventor specifically refused the application papers.

The declaration has the inventor state "I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above." The inventor cannot be asked to sign that statement under penalty of law, if the inventor has not been presented with a copy of the complete application, including the specification, claims and drawings. Applicants have not presented Mr. Tajima with a complete copy of the application papers and the declaration. Applicant's have not shown a refusal by conduct.

¹This is understood to mean that the inventor was presented with a declaration of inventorship, as indicated in the petition.

An express statement that the application papers should not be sent may be sufficient, but it is not found in this instance. The declaration of Asano and Murakami does not state date and time of their conversations with Mr. Tajima. MPEP 409.03(d). Further, the statement of Tajima expresses a general lack of desire to correspond with applicants. Mr. Tajima does not expressly state that he does not wish to be presented with the application papers for this application and will not sign the declaration.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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